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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,764	07/31/2001	Jeffry J. Grainger	020313-001100US	4015

20350 7590 02/09/2006

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EXAMINER

BONSHOCK, DENNIS G

ART UNIT PAPER NUMBER

2173

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/919,764

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

Dennis G. Bonshock

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-11-2000</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. It is hereby acknowledged that the following papers have been received and placed on record in the file: Amendment as received on 11-21-2005.

2. Claims 1-38 have been examined.

#### **Status of Claims:**

3. Claims 1-11, 13-18, 20, 21, 23-29, and 31-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al., Patent # 6,499,026, hereinafter Rivette.

4. Claims 12, 19, 22, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al., Patent # 6,499,026, hereinafter Rivette.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al., Patent # 6,499,026, hereinafter Rivette.

7. With regard to claim 1, which teaches a user interface that provides access to patent information comprising: a first display section that displays a plurality of first file links selectable by the user, each of the links providing access to a patent document, that was filed in or sent from a patent office stored on a computer readable medium in an image file format and a second display section which displays a plurality of second file links selectable by the user, providing access to a patent file associated with an application program and stored on a computer readable medium, Rivette teaches, in column 4, lines 10-14 and column 17, lines 35-38, a system for viewing patent related information comprising: a database used for storing patent information, in column 114, lines 5-40 and figures 117, 118, 123, and 124, a group pane for displaying top level patent group information and a document pane for displaying a list of patents and other documents in the selected group. With regard to claim 1, further teaching wherein when one of the first file links is selected an associated underlying resource is automatically returned, Rivette further teaches, in column 115, lines 1-15, that upon user selection of a patent file/document the actual document is displayed to the user using the user interface module. With regard to claim 1, further teaching the patent documents and the patent files accessible from the first and second display sections all pertain to the patent application, Rivette teaches, in column 114, lines 17-46 and figure 117, the information pertaining to patent documents where, if a user drills down to a specific application in the group pane, the only information left to be displayed in the document pane and notes pane would be the information specific to the application (title, abstract, inventor, notes, etc, of the patent application).

8. With regard to claims 2, 14, and 21, which teach the patent files stored on a computer readable medium in a format native to the application program or convertible to the native application program, Rivette teaches, in column 115, lines 8-15 and column 113, lines 10-35, the user interface module being an application program used in displaying patent files in a variety of formats.

9. With regard to claims 3 and 31, which teach at least one of the patent files accessible through the plurality of second file links corresponding to a patent document accessible through the first file links, Rivette teaches, in column 114, lines 21-25 and 40-46 and figure 117, the document pane being a list of document is the group pane showing that an overlap exists. Furthermore, a user can via drag-and-drop assign an association between panes.

10. With regard to claim 4, which teaches a third display section containing a correspondence between one or more of: inventor, in-house, or outside representative client systems, pertaining to the patent, Rivette teaches, in column 114, lines 47-57, column 20, lines 15-20, and figures 117 and 118, a notes pane containing correspondence generated by the users of the system.

11. With regard to claims 5, 18, and 29, which teach the first, second, and third plurality of file links being either html links or folders, Rivette teaches, in column 114, lines 13-21, column 115, lines 1-15 and in figures 123 and 124, file links being either folders or links to documents; and in column 123, lines 34-45, column 39, lines 39-54, and in figure 145a, files being linked by hyperlinks.

12. With regard to claim 6, which teaches the first, second, and third sections being a panel on a Web page, Rivette teaches, in column 123, lines 34-45, column 39, lines 39-54, and in figure 145a, the display being in a web browser for communication over a network.

13. With regard to claim 7, which teaches the sections on a Windows based environment, Rivette teaches, in column 34, lines 19-26, client systems display windows being in a Windows™ based environment.

14. With regard to claims 8 and 27, which teach the sections displayed adjacent to each other across a width of a display, Rivette teaches, in figure 117, the panes being display adjacent to one another across the width of the display.

15. With regard to claim 9, which teaches the second display section including a plurality of fourth file links, being prior art references, Rivette teaches, in column 123, lines 34-45 and figure 143a, documents access via the panels providing selectable file links to prior art documents.

16. With regard to claim 10, which teaches the first and second display sections being separate windows, Rivette teaches, in figure 117, the panes (Group Window, Document Window, and Notes Window) being in separate windows.

17. With regard to claim 11, which teaches the first and second display sections being panels of a single window, Rivette teaches, in figure 117, the panes (Group Pane, Document Pane, and Notes Pane) being in the same window 11702.

18. With regard to claim 13, which teaches a method of providing access to information pertaining to a patent application, said method comprising: storing said

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information on a computer readable medium, Rivette teaches, in column 4, lines 10-14 and column 17, lines 35-38, a system for viewing patent related information comprising a database used for storing patent information. With regard to claim 13, further teaching the information including a correspondence generated from one or more of an inventor client system, an in-house client system and outside representative client system, Rivette teaches, in column 114, lines 47-57, column 20, lines 15-20, and figures 117 and 118, a notes pane containing correspondence generated by the users of the system. With regard to claim 13, further teaching the information including patent documents filed in or sent from a patent office and patent files associate with said patent application, Rivette teaches, in column 114, lines 5-40 and figures 117, 118, 123, and 124, a group pane for displaying top level patent group information and a document pane for displaying a list of patents and other documents in the selected group. Rivette further teaches, in column 115, lines 1-15, that upon user selection of a patent file/document the actual document is displayed to the user. With regard to claim 13, further teaching at least some of the patent documents being stored in an image file format, Rivette teaches, in column 115, lines 1-15, the patent documents being stored in an image format. With regard to claim 13, further teaching at least some of the patent files being associated with an application program, Rivette teaches, in column 115, lines 8-15 and column 113, lines 10-35, the user interface module being an application program used in displaying patent files in a variety of formats. With regard to claim 13, further teaching accessing the computer readable medium with a computer processor used to generate on the display a first, second, and third separate sections comprising

said correspondence, said patent documents, and said patent files respectfully, Rivette teaches, in column 114, lines 5-12, the processing and displaying on the screen of the three windows, including group pane, document pane, and notes pane.

19. With regard to claims 15, 16, 25, and 26, which teaches a forth section including summary information related to the patent application, including at least title and file number and further comprising an information icon that when selected causes additional summary information to be displayed, Rivette teaches, in column 115, lines 1-15, column 123, lines 34-45, in figure 143a and in figures 125-127, that upon selection of a patent document a widow is displayed including patent summary information (title, file number, etc) and upon a further selection of a prior art reference within this widow additional information is displayed.

20. With regard to claim 17, which teaches the first, second, and third display sections comprising a plurality of rows containing a file link selectable by a user to allow the user to view one or more of the correspondence, Rivette teaches, column 115, lines 1-15 and in figure 118, the display sections comprising a plurality of rows of file links.

21. With regard to claim 20, which teaches computer implemented method of providing access to information pertaining to a patent application, said method comprising: storing said information on a computer readable medium, Rivette teaches, in column 4, lines 10-14 and column 17, lines 35-38, a system for viewing patent related information comprising a database on a server used for storing patent information. With regard to claim 20, further teaching the information including a correspondence generated from one or more of an inventor client system, an in-house client system and



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outside representative client system, Rivette teaches, in column 114, lines 47-57, column 20, lines 15-20, and figures 117 and 118, a notes pane containing correspondence generated by the users of the system. With regard to claim 20, further teaching the information including patent documents filed in or sent from a patent office and patent files associated with said patent application, Rivette teaches, in column 114, lines 5-40 and figures 117, 118, 123, and 124, a group pane for displaying top level patent group information and a document pane for displaying a list of patents and other documents in the selected group. Rivette further teaches, in column 115, lines 1-15, that upon user selection of a patent file/document the actual document is displayed to the user. With regard to claim 20, further teaching at least some of the patent documents being stored in an image file format, Rivette teaches, in column 115, lines 1-15, the patent documents being stored in an image format. With regard to claim 20, further teaching at least some of the patent files being associated with an application program, Rivette teaches, in column 115, lines 8-15 and column 113, lines 10-35, the user interface module being an application program used in displaying patent files in a variety of formats. With regard to claim 20, further teaching generating a web page from the server system on a client system comprising a first, second, and third separate sections comprising said correspondence, said patent documents, and said patent files respectively, Rivette teaches, in column 114, lines 5-12, the displaying on the screen of the three windows, including group pane, document pane, and notes pane. Where Rivette further teaches, in column 123, lines 34-45, column 39, lines 39-54, and in figure

145a, the display being in a web browser on a client system generated by communication over a network.

22. With regard to claim 23, which teaches the patent document being in a bit mapped format, Rivette teaches, in column 41, lines 42-45 and in column 115, lines 1-15, patent document image documents created in a bitmapped format.

23. With regard to claim 24, which teaches the patent documents stored in a bit mapped format include documents scanned from a paper document and documents generated from patent files, Rivette teaches, in column 41, lines 42-45 in column 115, lines 1-15, and column 2, lines 15-34, patent document image documents created in a bitmapped format from actual paper documents.

24. With regard to claim 28, which teaches the first and third sections comprising a create icon that when selected by a client system creates a document to be stored in that section, wherein at least some information in the document is populated with information stored in the database, Rivette further teaches, in column 115, line 44 through column 116, line 29, buttons in the first and third panels to add items to the listing.

25. With regard to claim 32, which teaches a server system for managing information related to patent applications comprising: a processor, a database, and a memory storing a computer program, Rivette teaches, in column 4, lines 10-14, column 14, line 46 through column 15, line 12 and lines 40-46, and column 17, lines 35-38, a server system for viewing patent related information comprising a database used for storing patent information, a processor, and a memory storing an computer program. With

regard to claim 32, further teaching the information including a correspondence generated from one or more of an inventor client system, an in-house client system and outside representative client system, Rivette teaches, in column 114, lines 47-57, column 20, lines 15-20, and figures 117 and 118, a notes pane containing correspondence generated by the users of the system. With regard to claim 32, further teaching the information including patent documents filed in or sent from a patent office and patent files associated with said patent application, Rivette teaches, in column 114, lines 5-40 and figures 117, 118, 123, and 124, a group pane for displaying top level patent group information and a document pane for displaying a list of patents and other documents in the selected group. Rivette further teaches, in column 115, lines 1-15, that upon user selection of a patent file/document the actual document is displayed to the user. With regard to claim 32, further teaching at least some of the patent files being associated with an application program, Rivette teaches, in column 115, lines 8-15 and column 113, lines 10-35, the user interface module being an application program used in displaying patent files in a variety of formats. With regard to claim 32, further teaching generating on the display a first, second, and third separate sections comprising said correspondence, said patent documents, and said patent files respectively, Rivette teaches, in column 114, lines 5-12, the processing and displaying on the screen of the three windows, including group pane, document pane, and notes pane.

26. With regard to claim 33, which teaches a networked system comprising: a communication network, with a client system comprising a processor and a display, and

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a server system comprising a processor, a database, and memory, Rivette teaches, in column 4, lines 10-14, column 14, line 46 through column 15, line 12 and lines 40-46, column 17, lines 35-38, and figures 3 and 11, a networked system for viewing patent related information comprising: a server with an a database used for storing patent information, a processor, and a memory, coupled to a client system comprising a display, and a processor. With regard to claim 33, further teaching the information including a correspondence generated from one or more of an inventor client system, an in-house client system and outside representative client system, Rivette teaches, in column 114, lines 47-57, column 20, lines 15-20, and figures 117 and 118, a notes pane containing correspondence generated by the users of the system. With regard to claim 33, further teaching the information including patent documents filed in or sent form a patent office and patent files associate with said patent application, Rivette teaches, in column 114, lines 5-40 and figures 117, 118, 123, and 124, a group pane for displaying top level patent group information and a document pane for displaying a list of patents and other documents in the selected group. Rivette further teaches, in column 115, lines 1-15, that upon user selection of a patent file/document the actual document is displayed to the user. With regard to claim 33, further teaching at least some of the patent files being associated with an application program, Rivette teaches, in column 115, lines 8-15 and column 113, lines 10-35, the user interface module being an application program used in displaying patent files in a variety of formats. With regard to claim 33, further teaching generating on the display a first, second, and third separate sections comprising said correspondence, said patent documents, and said patent files

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respectfully, Rivette teaches, in column 114, lines 5-12, the processing and displaying on the screen of the three windows, including group pane, document pane, and notes pane.

27. With regard to claim 34, which teaches the communication network being the Internet, Rivette teaches, in column 123, lines 34-45, column 39, lines 39-54, and in figure 145a, the display being in a web browser, such as Netscape (Navigator™) or Microsoft (Explorer™) (used for Internet based communication), for communication over a network.

28. With regard to claim 35, which teaches a computer graphical user interface that provides access to information pertaining to a patent application, said interface comprising: a first, second, and third display sections displayed side-by-side across a width of a display, Rivette teaches, in column 4, lines 10-14, a system for viewing patent related information comprising a database used for storing patent information, where Rivette further teaches, in column 114, lines 6-14 and figure 117, the three panes being display adjacent to one another across the width of the display. With regard to claim 35, further teaching display sections with a plurality of rows the first display section including image file links of history documents filed in or sent from a patent office and the second display section displaying document files associated with said patent application, Rivette teaches, column 115, lines 1-15 and in figure 118, the display sections comprising a plurality of rows of file links. Rivette further teaches, in column 114, lines 5-40 and figures 117, 118, 123, and 124, a group pane for displaying top-level patent group information and a document pane for displaying a list of patents and

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other documents in the selected group. Rivette further teaches, in column 115, lines 1-15, that upon user selection of a patent file/document the actual document is displayed to the user. Rivette further teaches, in column 115, lines 1-15, the documents/files being displayable in a text format and an image format. With regard to claim 35, further teaching the third display section including a correspondence generated from one or more of an inventor client system, an in-house client system and outside representative client system, Rivette teaches, in column 114, lines 47-57, column 20, lines 15-20, and figures 117 and 118, a notes pane containing correspondence generated by the users of the system. With regard to claim 35, which teaches the history documents, the application documents, and the correspondence documents pertain to the patent or patent application, Rivette teaches, in column 114, lines 17-46 and figure 117, the information pertaining to patent documents where, if a user drills down to a specific application in the group pane, the only information left to be displayed in the document pane would be the title, abstract, inventor, etc, of the patent application. With regard to claim 35, further teaching that when one of the file links is selected the associated underlying resource is automatically returned, Rivette further teaches, in column 115, lines 1-15, that upon user selection of a patent file/document the actual document is displayed to the user.

29. With regard to claim 36, which teaches a forth section including summary information related to the patent application spaced vertically from the first, second, and third display sections, including a title and an icon that when selected provides additional summary information, including at least title and file number, Rivette teaches,

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in column 115, lines 1-15, column 123, lines 34-45, in figure 143a and in figures 125-127, that upon selection of a patent document a widow is displayed including patent summary information (title, file number, etc) and upon a further selection of a prior art reference within this widow additional information is displayed.

30. With regard to claims 37 and 38, which teach the associated underlying resource comprises a document, a page, a folder, or a package, Rivette teaches, in column 115, lines 1-15 and figures 117, 118, 123, and 124, selection of a patent item automatically providing the document/page.

### ***Claim Rejections - 35 USC § 103***

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claims 12, 19, 22, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al., Patent # 6,499,026, hereinafter Rivette.

33. With regard to claims 12, 19, and 22, which teach the patent documents being locked and not available to be edited, Rivette teaches, in column 19, lines 48-53, that these documents are stored on a centralized server and represent actual Patents which obviously would not allow for a user to edit the patent images. One would have been motivated to make such an assertion because if client users could access the Patent

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Offices centralized electronic database of patents and edit them at any time a patent would hold no value, due to lack of enforcement of content.

34. With regard to claim 30, which teaches the first and third sections comprising a upload icon that when selected allows an electronic document to be associated with the patent application, Rivette teaches, in column 101, line 60 through column 102, line 19, an option for a user to update the database at the server with a local document. Rivette further teaches button on the toolbar for exporting data (see column 115, lines 44-60 and figure 135). Rivette doesn't explicitly state that there is a button that initiates this upload of notes, but it would be obvious that some form of initiating element would exist. One would have been motivated to have such a button because this would be easily allow a correspondence between individuals at different ends as is shown by the users setting of access rights to notes in column 20, lines 25-37.

### ***Response to Arguments***

35. The arguments filed on 11-21-2005 have been fully considered but they are not persuasive. Reasons set forth below.

36. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis G. Bonshock whose telephone number is (571)



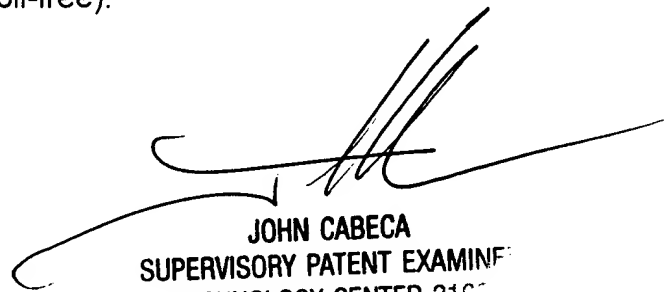
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272-4047. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 4:00 p.m.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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dgb



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